

SMALL BUSINESS TECHNOLOGY TRANSFER (STTR) PROGRAM**ALLOCATION OF RIGHTS IN INTELLECTUAL PROPERTY AND
RIGHTS TO CARRY OUT FOLLOW-ON RESEARCH, DEVELOPMENT,
OR COMMERCIALIZATION****(This is only a model)**

This Agreement between _____, a small business concern organized as a _____ under the laws of _____ and having a principal place of business at _____, ("SBC") and _____, a research institution having a principal place of business at _____, ("RI") is entered into for the purpose of allocating between the parties certain rights relating to an STTR project to be carried out by SBC and RI (hereinafter referred to as the "PARTIES") under an STTR funding agreement that may be awarded by _____ ("AGENCY") to SBC to fund a proposal entitled "_____ submitted, or to be submitted, to AGENCY by SBC on or about _____, 199__.

1. Applicability of this Agreement.

(a) This Agreement shall be applicable only to matters relating to the STTR project referred to in the preamble above.

(b) If a funding agreement for an STTR project is awarded to SBC based upon the STTR proposal referred to in the preamble above, SBC will promptly provide a copy of such funding agreement to RI, and SBC will make a subaward to RI in accordance with the funding agreement, the proposal, and this Agreement. If the terms of such funding agreement appear to be inconsistent with the provisions of this Agreement, the PARTIES will attempt in good faith to resolve any such inconsistencies. However, if such resolution is not achieved within a reasonable period, SBC shall not be obligated to award nor RI to accept the subaward. If a subaward is made by SBC and accepted by RI, this Agreement shall not be applicable to contradict the terms of such subaward or of the funding agreement awarded by AGENCY to SBC except on the grounds of fraud, misrepresentation, or mistake, but shall be considered to resolve ambiguities in the terms of the subaward.

(c) The provisions of this Agreement shall apply to any and all consultants, subcontractors, independent contractors, or other individuals employed by SBC or RI for the purposes of this STTR project.

2. Background Intellectual Property.

(a) "Background Intellectual Property" means property and the legal right therein of either or both parties developed before or independent of this Agreement including inventions, patent applications, patents, copyrights, trademarks, mask works, trade secrets and any information embodying proprietary data such as technical data and computer software.

(b) This Agreement shall not be construed as implying that either party hereto shall have the right to use Background Intellectual Property of the other in connection with this STTR project except as otherwise provided hereunder.

- (1) The following Background Intellectual Property of SBC may be used nonexclusively and, except as noted, without compensation by RI in connection with research or development activities for this STTR project (if "none" so state): _____;
- (2) The following Background Intellectual Property of RI may be used nonexclusively and, except as noted, without compensation by SBC in connection with research or development activities for this STTR project (if "none" so state): _____;
- (3) The following Background Intellectual Property of RI may be used by SBC nonexclusively in connection with commercialization of the results of this STTR project, to the extent that such use is reasonably necessary for practical, efficient and competitive commercialization of such results but not for commercialization independent of the commercialization of such results, subject to any rights of the Government therein and upon the condition that SBC pay to RI, in addition to any other royalty including any royalty specified in the following list, a royalty of ___% of net sales or leases made by or under the authority of SBC of any product or service that embodies, or the manufacture or normal use of which entails the use of, all or any part of such Background Intellectual Property (if "none" so state): _____.

3. Project Intellectual Property.

(a) "Project Intellectual Property" means the legal rights relating to inventions (including Subject Inventions as defined in 37 CFR ' 401), patent applications, patents, copyrights, trademarks, mask works, trade secrets and any other legally protectable information, including computer software, first made or generated during the performance of this STTR Agreement.

(b) Except as otherwise provided herein, ownership of Project Intellectual Property shall vest in the party whose personnel conceived the subject matter or first actually reduced the subject matter to practice, and such party may perfect legal protection therein in its own name and at its own expense. Jointly made or generated Project Intellectual Property shall be jointly owned by the PARTIES unless otherwise agreed in writing. The SBC shall have the first option to perfect the rights in jointly made or generated Project Intellectual Property unless otherwise agreed in writing.

(1) The ownership, including rights to any revenues and profits, resulting from any product, process, or other innovation or invention based on the cooperative shall be allocated between the SBC and the RI as follows:

SBC Percent: _____ RI Percent: _____

(2) Expenses and other liabilities associated with the development and marketing of any product, process, or other innovation or invention shall be allocated as follows:

SBC Percent: _____ RI Percent: _____

(c) The PARTIES agree to disclose to each other, in writing, each and every Subject Invention, which may be patentable or otherwise protectable under the United States patent laws in Title 35, United States Code. The PARTIES acknowledge that they will disclose Subject Inventions to each other and the awarding agency within ___ months after their respective inventor(s) first disclose the invention in writing to the person(s) responsible for patent matters of the disclosing Party. All written disclosures of such inventions shall contain sufficient detail of the invention, identification of any statutory bars, and shall be marked confidential, in accordance with 35 U.S.C. ' 205.

(d) Each party hereto may use Project Intellectual Property of the other nonexclusively and without compensation in connection with research or development activities for this STTR project, including inclusion in STTR project reports to the AGENCY and proposals to the AGENCY for continued funding of this STTR project through additional phases.

(e) In addition to the Government's rights under the Patent Rights clause of 37 CFR ' 401.14, the PARTIES agree that the Government shall have an irrevocable, royalty free, nonexclusive license for any governmental purpose in any Project Intellectual Property.

(f) SBC will have an option to commercialize the Project Intellectual Property of RI, subject to any rights of the Government therein, as follows--

(1) Where Project Intellectual Property of RI is a potentially patentable invention, SBC will have an exclusive option for a license to such invention, for an initial option period of _____ months after such invention has been reported to SBC. SBC may, at its election and subject to the patent expense reimbursement provisions of this section, extend such option for an additional _____ months by giving written notice of such election to RI prior to the expiration of the initial option period. During the period of such option following notice by SBC of election to extend, RI will pursue and maintain any patent protection for the invention requested in writing by SBC and, except with the written consent of SBC or upon the failure of SBC to reimburse patenting expenses as required under this section, will not voluntarily discontinue the pursuit and maintenance of any United States patent protection for the invention initiated by RI or of any patent protection requested by SBC. For any invention for which SBC gives notice of its election to extend the option, SBC will, within ___ days after invoice, reimburse RI for the expenses incurred by RI prior to expiration or termination of the option period in pursuing and maintaining (i) any United States patent protection initiated by RI and (ii) any patent protection requested by SBC. SBC may terminate such option at will by giving written notice to RI, in which case further accrual of reimbursable patenting expenses hereunder, other than prior commitments not practically revocable, will cease upon RI's receipt of such notice. At any time prior to the expiration or termination of an option, SBC may exercise such option by giving written notice to RI, whereupon the parties will promptly and in good faith enter into negotiations for a license under RI's patent rights in the invention for SBC to make, use and/or sell products and/or services that embody, or the development, manufacture and/or use of which involves employment of, the invention. The terms of such license will include: (i) payment of reasonable royalties to RI on sales of products or services which embody, or the development, manufacture or use of which involves employment of, the invention; (ii) reimbursement by SBC of expenses incurred by RI in seeking and maintaining patent protection for the invention in countries covered by the license (which reimbursement, as well as any such patent expenses incurred directly by SBC with RI's authorization, insofar as deriving from RI's interest in such invention, may be offset in full against up to _____ of accrued royalties in excess of any minimum royalties due RI); and, in the case of an exclusive license, (iii) reasonable commercialization milestones and/or minimum royalties.

(2) Where Project Intellectual Property of RI is other than a potentially patentable invention, SBC will have an exclusive option for a license, for an option period extending until _____ months following completion of RI's

performance of that phase of this STTR project in which such Project Intellectual Property of RI was developed by RI. SBC may exercise such option by giving written notice to RI, whereupon the parties will promptly and in good faith enter into negotiations for a license under RI's interest in the subject matter for SBC to make, use and/or sell products or services which embody, or the development, manufacture and/or use of which involve employment of, such Project Intellectual Property of RI. The terms of such license will include: (i) payment of reasonable royalties to RI on sales of products or services that embody, or the development, manufacture or use of which involves employment of, the Project Intellectual Property of RI and, in the case of an exclusive license, (ii) reasonable commercialization milestones and/or minimum royalties.

(3) Where more than one royalty might otherwise be due in respect of any unit of product or service under a license pursuant to this Agreement, the parties shall in good faith negotiate to ameliorate any effect thereof that would threaten the commercial viability of the affected products or services by providing in such license(s) for a reasonable discount or cap on total royalties due in respect of any such unit.

4. Follow-on Research or Development.

All follow-on work, including any licenses, contracts, subcontracts, sublicenses or arrangements of any type, shall contain appropriate provisions to implement the Project Intellectual Property rights provisions of this agreement and insure that the PARTIES and the Government obtain and retain such rights granted herein in all future resulting research, development, or commercialization work.

5. Confidentiality/Publication.

(a) Background Intellectual Property and Project Intellectual Property of a party, as well as other proprietary or confidential information of a party, disclosed by that party to the other in connection with this STTR project shall be received and held in confidence by the receiving party and, except with the consent of the disclosing party or as permitted under this Agreement, neither used by the receiving party nor disclosed by the receiving party to others, provided that the receiving party has notice that such information is regarded by the disclosing party as proprietary or confidential. However, these confidentiality obligations shall not apply to use or disclosure by the receiving party after such information is or becomes known to the public without breach of this provision or is or becomes known to the receiving party from a source reasonably believed to be independent of the disclosing party or is developed by or for the receiving party independently of its disclosure by the disclosing party.

(b) Subject to the terms of paragraph (a) above, either party may publish its results from this STTR project. However, the publishing party will give a right of refusal to the other party with respect to a proposed publication, as well as a ___ day period in which to review proposed publications and submit comments, which will be given full consideration before publication. Furthermore, upon request of the reviewing party, publication will be deferred for up to ___ additional days for preparation and filing of a patent application which the reviewing party has the right to file or to have filed at its request by the publishing party.

6. Liability.

(a) Each party disclaims all warranties running to the other or through the other to third parties, whether express or implied, including without limitation warranties of merchantability, fitness for a particular purpose, and freedom from infringement, as to any information, result, design, prototype, product or process deriving directly or indirectly and in whole or part from such party in connection with this STTR project.

(b) SBC will indemnify and hold harmless RI with regard to any claims arising in connection with commercialization of the results of this STTR project by or under the authority of SBC. The PARTIES will indemnify and hold harmless the Government with regard to any claims arising in connection with commercialization of the results of this STTR project.

7. Termination.

(a) This agreement may be terminated by either Party upon ___ days written notice to the other Party. This agreement may also be terminated by either Party in the event of the failure of the other Party to comply with the terms of this agreement.

(b) In the event of termination by either Party, each Party shall be responsible for its share of the costs incurred through the effective date of termination, as well as its share of the costs incurred after the effective date of termination, and which are related to the termination. The confidentiality, use, and/or non-disclosure obligations of this agreement shall survive any termination of this agreement.

AGREED TO AND ACCEPTED--

Small Business Concern

By: _____ Date: _____

Print name: _____

Title: _____

Research Institution

By: _____ Date: _____

Print name: _____

Title: _____